

**REMARKS**

I. Petition Under 37 C.F.R. § 1.136(a)

Pursuant to 37 C.F.R. § 1.136(a), applicants hereby petition for a two-month extension of the shortened statutory period set for reply to the Notice of Non-Compliant Amendment dated August 26, 2008. The Commissioner is authorized to charge the \$490.00 fee set forth in 37 C.F.R. § 1.17(a)(2) or any other fees which may be required or credit any overpayment to Deposit Account No. 50-0417.

II. Introduction

Claims 93, 118, 135 and 142 are cancelled without prejudice.

Claims 39-92, 94-117, 119-134, 136-141 and 143-144 are pending in this application.

Claims 39-92, 94-117, 119-134, 136-141 and 143-144 are rejected.

Applicants traverse these rejections based on the amendments above and the remarks set forth below. Applicants respectfully request reconsideration and allowance of the pending claims.

III. Applicants' Reply to Rejections Under 35 U.S.C. § 102

Claims 132-134, 137-141, and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 5,636,276 to Brugger ("Brugger"). Applicants respectfully traverse.

One aspect of applicants' invention is directed toward a computer-based library system that employs authentication and encryption protocols for the secure transfer of content to a client computer system and a mobile playback device. The mobile playback device is removably connectable to the client computer system. This novel system includes a library and information delivery system for accessing and obtaining selected digital information files. The library and information delivery system generally includes a library server having a plurality of digital information files and a client computer system coupled to the library server over a network. Also included is one or more mobile devices removably connectable to the client computer system. The client computer system includes logic for requesting a download of one or more selected digital information files from the library server and further includes targeting logic for downloading the selected digital information files to a specific mobile device.

Thus, for example, in operation, selected digital content files may be selected by a user and downloaded from the library

server to a specific mobile playback device based on targeting information in a targeting header. The targeting header information may be based on a player ID, which is indicative of a specific player. In one embodiment, the targeting header and the digital content files may be encrypted based on the player ID so that the content may be targeted to a specific player. After the selected information is received by the mobile playback device, the mobile playback device may perform certain authentication procedures to ensure the playback device is authorized to play the received content (e.g., by comparing information in the targeting header with information in the playback device, such as the player ID, etc.). Independent claims 39, 53, 56, 59, 72, 86, 110, 132 and 139 have been variously amended to more specifically point out and describe these novel features such as the use of a player ID in the targeted header as well as the encryption of the selected content and header files based on the player ID. Thus, applicants' claimed invention provides a robust and secure system in which the content is keyed to specific player(s) based on player ID and player ID encryption.

In contrast, Brugger fails to show or suggest these features anywhere. The Office Action dated June 14, 2005, at page 3, however, states that Brugger teaches "generating a

targeted header (core) that containing (sic) information indicative of a player ID corresponding to particular player for rendering content." Office Action dates June 14, 2005, page 3. Subsequently, in the Office Action dated December 12, 2006, this rejection was clarified by pointing out that the consumer code of Brugger is equivalent to the player ID specified in the pending claims. Id at page 2. Applicants respectfully disagree.

In support of this position, Brugger is cited at column 4, lines 41-68 and column 5, lines 64-68 (pertinent parts reproduced below).

The core 14 includes the basic information for the whole of the music information object. This information in principle comprises an object identification code 18 for unambiguous identification of the music information object, object structure information 20 which describes the design of the music information object, in particular the number and type of additional layers 16, a consumer code 22 which is assigned unambiguously to one consumer and is assigned by the supplier or, for example, can also be the network subscriber number, as well as an encryption table 24, which will be described in more detail further below.

Brugger column 4, lines 53-62 (emphasis added).

As an additional safety precaution, the terminal 6 must furthermore be equipped with an authorization device 36, for example in the form of a dongle, a chipboard, a PCMCIA board or a CD-ROM, which is made available by the supplier of the music information. Identification information for the identification of the consumer or of the terminal, such as the consumer code for example, is stored in encoded form on the authorization device, such that it can be called up by...

Brugger column 5, lines 60-67 (emphasis added).

Upon close inspection of these sections, however, it becomes clear that the consumer code of Brugger is not, and cannot be considered a player ID as specified in applicants' claims. Consequently, Brugger does not show or suggest a targeted header or encryption based on a player ID as specified in applicants' claims.

For example, Brugger explains that the consumer code is unambiguously assigned to one consumer (by the supplier, irrespective of the player) and that it is a network subscriber number, which may be stored on portable authentication device such a dongle, chipboard, PCMCIA card or CD-ROM (see excerpts above). Such consumer codes, however, cannot be considered a player ID. For example, a network subscriber number is merely a network address or password that identifies a certain network location or user, but not a player. With this approach, a consumer may use substantially any computer at a particular authorized network location or logon using any computer as long as the consumer has the proper password (irrespective of which player is being used). The consumer code of Brugger is completely player agnostic. Any player having the proper

consumer code is authorized. Thus, the network subscriber number is not and cannot be considered a player ID.

Similarly, a dongle, chipboard, PCMCIA card or CD-ROM all are intentionally designed to be transferable from one computer to another, so the consumer may freely move these portable authentication devices from one playback platform to another to access (again, irrespective of any specific player), and thus are player independent. Accordingly, a consumer code on these portable devices is not and cannot be considered to be a player ID.

Therefore, as demonstrated above, Brugger does not show or suggest a player ID, the generation of a targeted header including a player ID or encryption based on a player ID as specified in applicants' claims. Accordingly, applicants specifically request this anticipation rejection be withdrawn.

IV. Applicants' Reply to Rejections Under 35 U.S.C. § 103(a)

Claims 135-136 and 142-143

Claims 135-136 and 142-143 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Brugger in view of U.S. Patent No. 5,761,485 to Munyan ("Munyan"). Applicants respectfully traverse.

As explained above, one reason independent claims 132 and 139 are patentable over Brugger is because Brugger does not disclose a player ID, generating a targeted header or encrypting based on information indicative of a player ID. Independent claims 39, 53, 56, 59, 72, 86, 110, 132 and 139 have been variously amended to more specifically point out and describe these novel features. Because Munyan also fails to disclose these features, claims are allowable for at least the same reasons.

For example, Munyan describes an electronic book that has an updateable ROM memory 360 that stores electronic content. ROM memory 360 comprises 500 to 1000 megabytes or more of memory such as that provided by a PCMCIA card, EEPROMs, Flash memory devices, disk drives etc. See Munyan, column 14, lines 19-25. Munyan explains that as a security measure, each memory 360 is coupled to specific electronic book through the use of a security code such that a particular electronic book may access a certain memory device 360. See Munyan, column 14, lines 52-65.

However, applicants respectfully point out that this scheme described by Munyan is merely a password-based system that associates a first piece of hardware (the electronic book) with a second piece of hardware (memory device 360) on a restricted

basis. The electronic data stored on memory device 360 does not contain any information regarding the security code, and thus the data itself is not protected (based on a security code or otherwise). In fact, the electronic data described in Munyan does not include any security features whatsoever. Thus, Munyan merely provides a system having hardware-based security. Once the hardware password has been bypassed, data may be accessed freely, as no data protection is provided at all.

In contrast, the claimed invention specifies use of digital content files with targeting logic and encryption based on a player ID. Munyan does not disclose encryption or targeting logic at all. In fact, the password based device of Munyan does not encrypt content, but rather merely restricts access to unencrypted content files (e.g., content files in a standard unencrypted format) to those with the proper password (ID code). Accordingly, nothing in Munyan shows or suggests that Munyan uses or even recognizes the usefulness of targeted headers or encryption, nor does it show or suggest either of these features based on player ID.

Moreover, although Brugger does mention encryption, nowhere in Brugger is any mention made of modifying, changing, or basing the disclosed predetermined standard encryption technique based on external information, such as a player ID (otherwise the



decryption and encryption modules will not interoperate with one another). Thus, even if combined, at best, the combination would merely produce a hardware-based password protected system, that uses randomly encrypted content files. No teaching or suggestion of modifying encryption or generating targeted headers is provided.

Thus, for at least these reasons, applicants respectfully submit that the proposed combination of Munyan and Brugger fail to show or suggest the claimed invention including the use of targeted headers or encryption based player IDs. Accordingly, applicants respectfully request the obviousness rejection be withdrawn and that claims 135-136 and 142-143 proceed to allowance.

Claims 39-131

Claims 39-131 have been rejected based on various combinations of Brugger, Munyan, U.S. Patent 6,230,173 to Ferrel et al. ("Ferrel") and U.S. Patent 4,855,725 to Fernandez ("Fernandez").

As explained above, one reason the pending claims are patentable over Brugger in view of Munyan is because these references, either alone or in combination do not show or suggest a player ID, generating a targeted header or encrypting

based on information indicative of a player ID. Independent claims 39, 53, 56, 59, 72, 86, 110, 132 and 139 have been variously amended to more specifically point out and describe these novel aspects of the invention.

Because both Ferrel and Fernandez also fail to show or suggest these features, the proposed combination of Munyan, Brugger, Ferrel and/or Fernandez also fails for at least the same reasons. See, for example, *Gentry Gallery, Inc. v. Berkline Corp.* 134 F.3d 1473, 45 USPQ2d 1498 (CAFC 1998). Accordingly, applicants respectfully submit claims 39-131 and are patentable over the prior art of record and requests this obviousness rejection be withdrawn.

Not Obvious to Combine

Furthermore, applicants submit it is not obvious to combine the references as proposed. This is true for at least several reasons. For example, there is no motivation provided in the references themselves suggesting such a combination. The Office Action states that such motivation may be "found in the knowledge generally available to one of ordinary skill in the art" (Office Action at 3). However, the level of skill in the art *cannot* be relied upon to provide the suggestion to combine references. See, for example *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) and MPEP § 2143.

In addition, no finding has been made of a specific understanding within the knowledge of a skilled artisan that would motivate one with no knowledge of the invention to arrive at the claimed limitation. See, for example, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Thus, the proposed combination is improper.

Moreover, applicants point out that substantial modification of Brugger would be required to accommodate the features of Munyan. No teaching is provided by either reference describing how to accomplish such modifications, discouraging such a combination. Further, the hardwired dumb terminal playback system of Brugger teaches away from the personal electronic book described in Munyan.

Additionally, based on the above, applicants further submit that the proposed combination is based on impermissible hindsight reconstruction, as the Examiner is merely picking and choosing from among the limitations in the references to produce the claimed invention. See, for example, *ATD Corp. v. Lydall, Inc.* 48 USPQ2d 1321 (Fed. Cir. 1998) "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the invention." Thus, the proposed combination is improper.

Accordingly, applicants request that the obviousness rejection be withdrawn.

V. Applicants' Reply of 9/1/06

Although certain claims have been amended herein in an effort to expedite prosecution of this case by further pointing out and more particularly defining the present inventions, applicants hereby reincorporate by reference all of the arguments offered in the reply of 9/1/06 which are still believed to demonstrate patentable distinctions over the current rejections (which are essentially the same as the previous rejection). Applicants reserve the right to present any of those arguments in any subsequent appeal that may occur in this case.

VI. Conclusion

For the foregoing reasons, Applicants respectfully submits that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 39-144 are respectfully requested. The Examiner is encouraged to contact Applicants' undersigned representative to discuss any matter that may expedite prosecution of this case.

Respectfully submitted,

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